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REMARKS

Claim rejections under 35 USC 103 as to Budge in view of Bates

Claims 1-2, 8-14, and 19-20 have been rejected under 35 USC 103(a) as being unpatentable over Budge (6,564,248) in view of Bates (6,721,781). Claims 1, 12, and 19 are independent claims, from which claims 2, 8-11, 13-14, and 20 depend. Applicant submits that claims 1, 12, and 19 are patentable over Budge in view of Bates, such that claims 2, 8-11, 13-14, and 20 are patentable for at least the same reasons.

Applicant specifically discusses claim 12 as representative of claims 1, 12, and 19 insofar as patentability over Budge in view of Bates is concerned. Claim 12 is limited to “an audio or video program encompassing the one or more audio or video controls [being] *integrated with* the predetermined application program,” where “the audio or video program [is] *separate from* the predetermined application program.” That is, claim 12 has two specific limitations that are discussed herein: (1) the audio or video program encompassing the audio or video controls is “integrated with” the predetermined application program, but (2) the audio or video program is also “separate from” the predetermined application program.

Furthermore, claim 12 was previously amended so that it is clear that the “audio or video program” is the program that “present[s] one or more audio or video controls for use in conjunction with the predetermined application program.” That is, claim 12 is limited to both an audio or video program and a predetermined application program, where it is the audio or video program that specifically presents the audio or video controls for use in conjunction with the predetermined application program.

Applicant contends that all these limitations are not found in Budge in view of Bates, or that Budge in view of Bates does not render these limitations obvious, for the following reasons. First, Budge does not disclose the limitations of the claimed invention as indicated by the Examiner, such that the claimed invention is not obvious over Budge in view of Bates. Second,

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Bates does not disclose the limitations of the claimed invention as indicated by the Examiner, such that the claimed invention is not obvious over Budge in view of Bates. Third, Bates is not properly combined with Budge, such that the claimed invention is not obvious over Budge in view of Bates. Each of these reasons is now discussed.

1) Budge does not disclose certain limitations of the invention as indicated by the Examiner

The Examiner relies upon Budge as teaching the detection of an event related to a predetermined application program, and an audio or video program presenting audio or video controls in conjunction with the predetermined application program. Because the Examiner specifically relies upon Budge in teaching this aspect of the claimed invention, Applicant discusses Budge in particular to show why Budge in view of Bates does not disclose this aspect of the claimed invention. That is, Applicant is very much cognizant that the instant rejection was proffered under 35 USC 103(a) over Budge in view of Bates; Applicant discusses Budge alone in this section of the office action response because the Examiner relied upon Budge alone in teaching certain aspects of the claimed invention, and Applicant disagrees with the Examiner's interpretation of Budge.

The Examiner specifically indicates in paragraph 26 on page 8 of the Final Office Action that the predetermined application program of Budge is the "operating system software" whereas the audio or video program of Budge is the "video e-mail software 50."¹ The claimed invention is

¹ It is noted that this is different than the interpretation the Examiner proffered in the previous Office Action, in which the audio or video program of Budge was recited as being the video e-mail software 50. It is difficult for Applicant to properly assess and respond to the Examiner's rejections where he keeps interpreting the prior art references differently vis-à-vis the claimed invention during the course of prosecution. Applicant wonders why the Examiner felt it necessary

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limited to a predetermined application program, and an audio or video program that is *separate from* the predetermined application program, where the audio or video program is the program that presents the audio or video controls.

Most generally, an operating system is not an application program

Applicant asserts that an operating system, however, cannot be properly construed as a predetermined application program consistent with the claimed invention. It is true that the Examiner has an obligation to interpret the claims as broadly and as reasonably as possible during prosecution. However, it is noted that the interpretation of the claims is to be accomplished to provide the claims with their broadest and most reasonable meaning, consistent with the ordinary and accustomed meaning of the claim language to those of ordinary skill within the art. That is, the general rule of claim interpretation is that terms in a claim are to be given their ordinary and accustomed meaning. (Renishaw PLC v. Marpos Societa per Azioni, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998); York Prods., Inc. v. Central Tractor Farm & Family Ctr., 99 F.3d 1568, 1572, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996))

To support Applicant's contention that an operating system is not properly, broadly, and generally considered an application program, Applicant turns to two pieces of evidence presented in the co-filed Form 1449. First, the www.techtarget.com online dictionary of operating system states the following.

An operating system (sometimes abbreviated as "OS") is the program that, after being initially loaded into the computer by a boot program, manages *all the other programs* in a computer. *The other programs* are called *applications or application programs*. The application programs make use of the operating system by making requests for services through a defined application programming interface (API).

to interpret Budge one way in the previous office action, and another way in the current office action.

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This definition of *operating system* makes it clear that the ordinary and accustomed meaning of the terminology *operating system*, to those of ordinary skill within the art, is such that it is not considered an *application program*. Rather, an operating system is a program that manages *all the other programs* running, which are called *application programs*. Therefore, Budge cannot be considered as teaching a predetermined application program as to which the claimed invention is limited, as broadly and reasonably interpreted, such that Budge in view of Bates does not teach all the claim limitations, and thus does not render the claimed invention unpatentable.

Second, consider the Computer Desktop Encyclopedia definitions of system software and application program. The definition of system software is as follows.

Programs used to control the computer and develop and run application programs. It includes operating system *Contrast with application program*.

Furthermore, the definition of application program is as follows.

Any data entry, update, query or report program that processes data for the user *Contrast with system program*.

The diagrams associated with these two definitions are also informative. In the first diagram provided in relation to the definition of an application program, the operating system is clearly shown as being separate from application programs. In the second diagram provided in relation to the definition of system software, the system software is seen as including the operating system, which is separate from the system software. Thus, an operating system is different than an application program, insofar as an operating system is to be *contrasted with* an application program (and vice-versa), such that the two types of programs are different. Therefore, Budge cannot be considered as teaching a predetermined application program as to which the claimed invention is limited, as broadly and reasonably interpreted, such that Budge in view of Bates does not teach all the claim limitations, and thus does not render the claimed invention unpatentable.

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Special consideration as to claim 1 in particular

Applicant also notes that the above interpretation of “operating system” vis-à-vis “application program” as to the claimed invention generally invites and requires special and additional consideration as to claim 1 in particular. Claim 1 is limited to “an operating system,” “an application program running on the operating system,” and “an audio or video program running on the operating system.” Under the Examiner’s interpretation, the “audio or video program” of the claimed invention is the “video e-mail software 50” of Budge. However, the Examiner also considers the “application program” of the claimed invention as the “operating system” of Budge. You are thus left with a conundrum – what element of Budge is the actual “operating system” of the claimed invention, then?

That is, claim 1 is limited to three particular elements. The Examiner has corresponded the application program (a first element of claim 1) as the operating system of Budge and the audio or video program (a second element of claim 1) as the video email software of Budge. The Examiner has not identified a third program in Budge that corresponds to the actual operating system (a third element) in claim 1. (As before, Applicant concentrates on Budge here, even though this is a rejection proffered under 35 USC 103, because the Examiner has concentrated on Budge as teaching these aspects of the claimed invention. Insofar as Budge does not teach the elements of the claimed invention as indicated by the Examiner, then Budge in view of Bates cannot render the claimed invention unpatentable.)

The more proper interpretation of Budge is to have the operating system of Budge be the operating system of claim 1, and the video email software of Budge correspond to the audio or video program of claim 1. However, you then do not have an application program in Budge that corresponds to the application program of claim 1. If you use the Examiner’s most recent interpretation, that the operating system of Budge is the application program of claim 1, you are left with a nonsensical interpretation of claim 1: where “an application program running on the operating system” in claim 1 becomes “the operating system running on the operating system” as

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to Budge. This does not make sense – why and/or how would an operating system run on an operating system, where the former operating system is the latter operating system.

Applicant points out this conundrum with respect to claim 1 in particular to refute the Examiner's contention that "Applicant attempts to impute through argument [that] Claimed subject matter, not the specification is the measure of the invention," where "limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art." (Final Office Action, p. 8, para. 26) Here, Applicant is not imputing any portion of the specification into claim 1. In claim 1, an "operating system" is recited, an "application program running on the operating system" is recited, and "an audio or video program running on the operating system" is recited. Under any broadest and most reasonable interpretation of this claim, there is no way you can say that an application program running on the operating system is the actual operating system itself. Applicant is definitively not resorting to the specification with respect to claim 1. Thus, at very minimum, there is no way Budge in view of Bates teaches all the limitations of claim 1.

Applicant is amenable to limiting the other independent claims to also recite an operating system, if the Examiner believes that would render all the claims patentable over the cited prior art. That is, while Applicant firmly believes that the proper way to interpret what an "application program" is precludes an operating system from being an application program, as noted above, Applicant nevertheless is open to amending the other independent claims to recite such an operating system if doing so would advance the present patent application to allowance.

2) Bates does not disclose certain limitations of the invention as indicated by the Examiner

In the previous office action response, Applicant explained in considerable detail why Bates does not teach an application program being separate but integrated with the audio or video program, as to which the claimed invention is limited, such that this was an additional and *separate* reason why Budge in view of Bates does not render the claimed invention unpatentable.

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Applicant refers the Examiner to the previous office action response in this regard, and this argument is not repeated here to avoid redundancy.

In the Final Office Action, however, the Examiner did not even consider this separate and independent basis of patentability. Rather, the Examiner merely states that “[i]n the remarks, Applicant argued in substance that Budge does not teach a predetermined application program and an audio or video program that is separate from the predetermined application program.” (P. 8, para. 24) This is true. But Applicant also made arguments about program integration in *Bates* as well. Specifically, Applicant *argued that Bates does not teach an application program being separate but integrated with the audio or video program.*

The Examiner must consider *all* of Applicant’s arguments, and not just the *first* or *one* of Applicant’s arguments. At great expense, Applicant formulated a complete response to the previous office action. The Examiner simply ignored a key argument that Applicant presented. Therefore, Applicant requests that the Examiner consider this argument in detail, as it is a separate and independent basis for patentability. That is, regardless of whether an operating system is an application program or not, the claimed invention is nevertheless patentable, because *Bates* does not disclose all the limitations of the invention.

3) Budge is not properly combined with Bates

In the previous office action response, Applicant also explained in considerable detail why Budge is not combinable with Bates, and this was also another *separate* reason why Budge in view of Bates does not render the claimed invention unpatentable. Applicant again refers the Examiner to the previous office action response in this regard, and this argument is not repeated here to avoid redundancy.

The Examiner also ignored this separate and independent basis of patentability in the Final Office Action. The Examiner does not particularly acknowledge having considered it, and does not particularly respond to it. Therefore, Applicant requests that the Examiner consider this

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argument in detail, as it is a separate and independent basis for patentability. That is, regardless of whether an operating system is an application program or not, the claimed invention is nevertheless patentable, because Budge is not properly combined with Bates as indicated by the Examiner.

Claim rejections under 35 USC 103 as to Budge in view of Bates and further in view of Poreh

Claims 3-7 and 15-18 have been rejected under 35 USC 103(a) as being unpatentable over Budge in view of Bates, and further in view of Poreh (5,889,518). However, claims 3-7 and 15-18 are dependent claims, depending from the independent claims discussed above in relation to the claim rejections as to Budge in view of Bates. Therefore, claims 3-17 and 15-18 are patentable for at least the same reasons that their base independent claims are patentable.

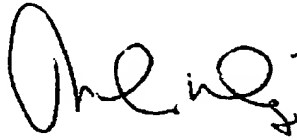
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Conclusion

Applicant has made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Michael Dryja, Applicant's Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited. Applicant strongly contends that the Examiner's rejection of the claimed invention would not be sustained on appeal.

Respectfully Submitted,



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Date

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